

II. REMARKS

Upon entry of the amendment, claims 1-7, 9-11, 14-44, 46-48, and 51-56 will be pending.

Regarding the Amendments

Claim 1 has been amended to more clearly define the claimed fusion protein, which includes a polyanionic domain that binds to a polycationic coating and has the recited formula. The amendment is supported, for example, at page 3, paragraph 0013; page 7, paragraphs 0026-0027; page 9, paragraph 34; and original claims 8 and 12.

Claims 9, 14-18, 46, and 51-55 have been amended to properly depend from preceding claims and, therefore, merely address a formality.

Claims 39 and 40 have been amended to more clearly define the fusion protein of the array and microarray, respectively. The amendment merely clarifies the claimed subject matter and is supported in the specification at page 3, paragraph 0013; page 7, paragraphs 0026-0027; page 9, paragraph 34; and original claims 45 and 49.

As such, the amendments to the claims are supported by the specification, including the claims as originally filed and, therefore, do not add new matter. Accordingly, entry of the amendments is respectfully requested.

Regarding the Restriction Requirement

It is stated in the Office Communication that the claims are directed to three independent and patentably distinct inventions, which have been set forth as follows:

Group I: claims 1-18 and 56, directed to a protein classified in class 530, subclass 350;

Group II: claims 19-38, directed to a method for non-covalently attaching a subject protein to a solid support or to a method of producing an array, classified in class 435, subclass 7.9; and

Group III: claims 39-55, directed to a microarray, classified in class 436, subclass 518.

It is requested that Applicants' elect one group of claims for examination. Although the Restriction Requirement is traversed for the reason set forth below, Applicants nevertheless elect the claims of Group I, claims 1-18 and 56, for examination.

The division of the claims of Group I and III from those of Group II is traversed because, while the fusion protein of claims 1-18 and 56 and the methods of attaching a protein to a solid support of claims 19-38 are related, for example, as product and process of use, the Examiner has not established an alternative use for the fusion protein as required under MPEP § 806.05(h). It is stated in the Office communication that the fusion protein could be used as a therapeutic agent. It is unclear, however, what therapeutic activity the Examiner believes would be added to a subject protein via fusion to a polyanionic domain that binds to a polycationic coating deposited on a solid support. As such, Applicant submits that the Examiner has not met the requisite burden and it is respectfully requested that the division of Groups I and III from Group II be

reconsidered and that the Examiner rejoin and examine the claims together with the elected claims.

The division of the claims of Group I from those of Group III is traversed because a fusion protein as defined by claims 1-18 and 56 (Group I) is a subcombination or necessary element of the microarray defined by the claims 39-55 (Group III). Applicants further submit that the fusion protein of the claims of Group I and the microarray having such a fusion protein, as recited in the claims of Group III, are so closely related that an examination of the microarray would be dependent upon an examination of the fusion protein of claim 1 (Group I) such as to make a separate examinations of Groups I and III duplicative. As such, it is submitted that because the fusion protein of Group I is an element of the microarray of Group III, it would not constitute an undue burden on the Examiner to search and examine the claims of Group I with those of Group II, whereas the division of the claims and the requirement to file a separate application to pursue the claims of Group III would constitute a waste of U.S. Patent and Trademark Resources by requiring duplicative searches and examination. Accordingly, it is respectfully requested that the division of the claims of Group I and Group III be reconsidered, and that the Examiner rejoin and examine claims 39-55 together with elected claims 1-18 and 56.

It is submitted that the claims are in condition for allowance, and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to the subject application.

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David A. Tirrell
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Attorney Docket No.: CIT1530-1

The Commissioner is hereby authorized to charge any additional fees associated with the filing submitted herewith, or credit any overpayment, to Deposit Account No. 07-1896, referencing the Attorney Docket number shown above.

Respectfully submitted,

Date: January 14, 2005

A handwritten signature in cursive script, reading "Lisa A. Haile", written over a horizontal line.

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